

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Fabrice CLERC

Serial No.: 10/578,755

Filed: May 8, 2006

For: Method for the Automatic Control of Fraud in an
Electronic Transaction System

Examiner: Zia, Syed
Group Art: 2431

Conf. No.: 1496

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Commissioner for Patents
P.O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This Pre-Appeal Brief Request for Review (“Request”) is submitted in accordance with the U.S.P.T.O. Official Gazette Notice “New Pre-Appeal Brief Conference Pilot Program,” dated July 12, 2005. The present Request is filed concurrently with a Notice of Appeal and is filed before the filing of an Appeal Brief. No amendments are being filed with this request.

Remarks/Arguments supporting the Request begin on page 1 of this paper.

REMARKS/ARGUMENTS

This Request is filed in response to the final Office Action dated December 23, 2009.

Claims 1 and 3-11 are pending in this application, with claim 1, 9, and 10 being independent.

In the final Office Action, claims 1 and 3-11 were rejected under 35 U.S.C. § 102(e) as anticipated by Mirabella (U.S. 2004/0167859).

The alleged *prima facie* case in support of the rejection of claims 1 and 3-11 suffers from at least the clear deficiency that the cited reference does not disclose all of the elements of the claims.

The embodiments described in the present application relate to automatically controlling the number of times a user can access an online service. For example, a user may be authorized to download a particular software application a limited number of times. Each time the user accesses the service, an equation is generated having a predetermined number of unknowns (n). Once the nth equation has been generated, it is possible to solve the system of equations to determine the identity of the user. Up until that time, the user's identity is protected.

Claim 1 is directed to a method of automatically controlling fraud in an electronic transaction system. The method includes:

- (i) "generating an element and storing the element in a database in association with information identifying a session initiated by a user when the user initiates the session in the electronic transaction system;"
- (ii) "each time during the session that the user commands the execution of an operation, determining an equation that is satisfied by the element stored in the database;"

(iii) "solving a system of independent equations comprising the determined equations to deduce the element therefrom when a number of the determined equations is greater than a number of authorized operations;" and

(iv) "deducing from the obtained element, by consulting the database, the associated information identifying the user that initiated the session."

Mirabella discloses a software license management system configurable for a post-use payment business model. The management system is designed to detect and inform a vendor when a customer who owns a particular number of licenses uses more than that number during a certain period of time. (Mirabella, ¶10 and Fig. 9).

Mirabella discloses an architecture in which front-end servers (i.e., at a customer side) observe the use of licenses purchased by the customer on a pool of computers, and these front-end servers regularly send report logs on the use of licenses to back-end servers (i.e., at a vendor side). (Mirabella, Figs. 1-5). The license manager controls usage of the licensed software according to license terms and generates, as appropriate, a report log of such usage. (Mirabella, ¶48). The back-end servers process report logs received from the front-end servers. Different report formats are presented which deal specifically with instances of overusage. (Mirabella, ¶¶53-55). Information such as user name or host computer can be part of these reports. However, user and host identifications may be coded by the customer, so that the vendor cannot correlate specific users and their usage. (Mirabella, ¶55).

It is clear from the above that Mirabella is concerned with tracking and reporting overusage of licenses for a particular customer site, as opposed to providing a way for automatically revealing to a vendor the identity of a particular user who exceeds a predetermined

number of access attempts, in the manner described in the present application. It is unsurprising, then, that Mirabella does not disclose any of the features of claim 1.

For example, the Examiner has not found anything in Mirabella remotely resembling generating equations or solving a system of independent equations. Indeed, the word “equation” does not even appear in Mirabella.

The basis for the rejection of claim 1 presented in the Office Action is merely the language of the entire claim followed by a citation to Figures 1-10 and paragraphs 93-102 of Mirabella. The cited portion of Mirabella describes the operation of the back-end servers, which as discussed above, accumulate usage information and generate usage reports. However, nothing in this cited portion, or elsewhere in Mirabella, discloses: (ii) “each time during the session that the user commands the execution of an operation, determining an equation that is satisfied by the element stored in the database;” and (iii) “solving a system of independent equations comprising the determined equations to deduce the element therefrom when a number of the determined equations is greater than a number of authorized operations,” as recited in claim 1.

As discussed above, these features of claim 1 allow the identity of the user to be kept secret until the authorized number of accesses is exceeded, because the system of equations cannot be solved until the last equation is generated. Mirabella does not disclose equations of any kind, much less a system of independent equations used in the manner recited in claim 1. *A fortiori*, Mirabella fails to disclose the generation and storage of an element that satisfies the equations. Storing this element in association with the session identifying information allows the user information to be ascertained after the system of equations is solved. Thus, Mirabella does not disclose: (i) “generating an element and storing the element in a database in association with

information identifying a session initiated by a user when the user initiates the session in the electronic transaction system," as further recited in claim 1.

It follows then that Mirabella also does not disclose: (iv) "deducing from the obtained element, by consulting the database, the associated information identifying the user that initiated the session," as further recited in claim 1.

In view of the above, it is apparent that the *prima facie* case in support of the rejection of independent claim 1 suffers from the clear deficiency that the cited reference does not disclose all of the elements of claim 1 (and in fact does not disclose any of the claimed elements). Accordingly, claim 1 is deemed to be patentable over Mirabella.

Independent claims 9 and 10 recite features similar to claim 1 and are therefore also deemed to be patentable over Mirabella for reasons discussed above with respect to claim 1. Dependent claims 3-8 and 11, which depend from claim 1, distinguish the invention over Mirabella for reasons discussed above in regard to claim 1 as well as on their own merits.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,
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